

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-10, 21-30, and 44-49 are presently active in this case. Claims 11-20, and 31-43 were cancelled in response to a restriction requirement. The present Amendment amends Claims 9, 21, and 44 without introducing any new matter.

The November 12, 2009 Office Action rejected Claims 1-10, 21-30, and 44-46 over the grounds of the non-statutory, obviousness-type, double-patenting doctrine, as being unpatentable over Claims 1, 4, and 12-21 over the co-pending Application with the Serial No. 10/594,993. Claims 21-30, 44-46, and 48-49 were rejected as being directed to non-statutory subject matter under 35 U.S.C. § 101. Claims 21-30 and 44-46 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 21-30 and 44-46 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-10, 21-30, and 44-9 were rejected under 35 U.S.C. § 103 as being unpatentable over Flagg (U.S. Patent No. 6,456,979) in view of Moller et al. (BMJ medical journal publication, 1995, vol. 310, pp. 1500-1501, hereinafter "Moller") in further view of Silver (U.S. Patent No. 6,269,339.)

In response to the obviousness-type double-patenting rejection over the co-pending Application with the Serial No. 10/594,993, Applicants herewith file a Terminal Disclaimer against Application Serial No. 10/594,993. However, Applicants also submit that the filing of a terminal disclaimer is not an admission of the propriety of the double-patenting rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

In response to the rejection of Claims 21-30 and 44-46 under 35 U.S.C. §§ 101 and 112, first paragraph, Applicants traverse these rejection for the same reasons as set forth in

the Response that was filed on February 12, 2010 on pages 10-12. However, in the spirit of moving the prosecution of this application forward, Applicants herewith amend independent Claims 21 and 44 to recite that the system includes a hardware processor, and that the functional units are operating on the hardware processor. These features find non-limiting support in Applicants' disclosure as originally filed, for example in the specification at page 14, lines 17-24. No new matter has been added. Accordingly, Applicants respectfully submit that these rejections are addressed.

In response to Office Action's assertion that some of the features of Claims 1-2 merely represent "intended use language" and that the features are not "positively claimed," Applicants traverse this statement. (Office Action, p. 8, ll. 10-15, p. 9, ll. 4-6.) The Office Action is basically asserting by a conclusionary statement that the results a specific data transformation of a method step merely indicate "intended use," without citing any authority as to why such language could be considered a non-limiting intended use wording. This reasoning is improper, as next discussed.

"Intended use" or "field of use" statements in a claim language are statements that indicate in which context, application, or environment a specific claim or claim element is to be used, without providing any further limitations to the structure of the claim. As an example, a phrase in the claim drawn to a head for a lacrosse stick stating "which provides improved playing and handling characteristics" is an intended use statement and was not considered a claim limitation. *STX LLC. v. Brine*, 211 F.3d 588, 591, 54 USPQ2d 1347, 1350 (Fed. Cir. 2000).

In particular, by asserting "intended use," the Office Action makes the following statements regarding the features of Applicants' independent Claim 1:

The claim language "to determine a relative risk ratio for each of the risk classes, to determine a dependence between the at least two different risk classes, to characterize the relative risks associated with the plurality of

products and to generate comparative risk data to characterize the relative risks associated with the plurality of products” represent intended use language and therefore do not carry any patentable weight (see MPEP form paragraph 7-37-09.)

(Office Action, p. 8, ll. 10-15.) Applicants traverse this statement. For example the step of “dividing the expected occurrence rates determined by said step of determining by an average rate by the processor to determine a relative risk ratio for each of the risk classes,” performs a division of data by average rates, and the result of this division is transformed data, that indicates “a relative risk ratio for each of the risk classes.” In other words, a processing step is performed, that transforms a first set of data into a second set of data. Applicants respectfully traverse the statement that these steps of data transformation merely evoke an “intended use.” If the reasoning of the pending Office Action would be followed, any data transformation of a method claim would not limit the scope of the claim, because it would be considered “intended use.” This reasoning is clearly erroneous, and therefore, Applicants request proper examination of the claimed method steps.

In response to the rejection of Claims 1-10 under 35 U.S.C. § 103(a), Applicants respectfully request reconsideration of this rejection and traverses the rejection, as discussed next.

Briefly summarizing, Applicants’ independent Claim 1 is directed to a method of characterizing relative risks associated with a plurality of financial products performed on a computer having a processor. The method includes the steps of identifying one or more risk classes associated with the plurality of financial products by using an input device of the computer, determining, for each of the risk classes, an expected occurrence rate by the processor, dividing the expected occurrence rates determined by said step of determining by an average rate by the processor to determine a relative risk ratio for each of the risk classes, calculating correlated risk ratios between at least two of the risk classes that are identified in

said step of identifying to determine a dependence between the at least two different risk classes, and *comparing the relative risk ratios and the correlated risk ratios by the processor with empirical data to generate comparative risk data to characterize the relative risks associated with the plurality of products; correcting the relative risk ratios in a case there the comparative risk data is out of a defined range compared to the empirical data;* and storing the corrected risk ratios to a storage unit of the computer.

The February 22, 2010 Office Action admits that the steps of comparing and correcting are not taught by the references Flagg and Moller. (See Office Action, p. 7, ll. 9-13.) However, the pending Office Action asserts that the reference Silver teaches a similar feature in his Figure 11, at column 1, lines 17-22, and column 7, lines 59-67, and by contending that the combination of Silver with the reference Flagg is proper. Applicants traverse these statements as next discussed.

The rejection reference Silver is directed to a method for determining a wellness plan for a user 100, by determining a user's physiological age in a step 310, and a wellness program is put together based on wellness options that a user has chosen based on health science. (Silver, Abstract, Figs. 1, 3.) Silver explains that his system allows to "interactively assist, motivate, and counsel the user in choosing health behavior interventions to move a user from a current relative risk level to a preferred lower level of risk." (Silver, col. 1, ll. 17-20.) Moreover, Silver sets forth an example where the composite relative risk 804 associated with a user's behavior through the use of a covariance model is calculated to determine the physiological age. (See Silver, Fig. 7, steps 804, 806, col. 3, ll. 57-59, col. 11, ll. 50-65.) In particular, Silver calculates a composite relative risk 1308 by a covariance adjustment, so that individual effects that influence the overall relative risk can be isolated. (Silver, col. 13, ll. 29-37.) This is possible because the covariance is a statistical measurement of how individual effects mutually affect each other. (Silver, col. 13, ll. 38-39.) Silver then gives

more details to his algorithm to calculate the composite relative risk ratios. (Silver, col. 14, ll. 5-19.) In particular, Silver explains that the overall population is stratified by a chosen factor, and the composite relative risk value is calculated based upon a retrieved associated covariance of the single stratified population. (Silver, col. 12, ll. 36-42, col. 13, ll. 29-37.) Stratified sampling is a method of sampling from a population, that is used when a sub-populations have considerably variable characteristics. In such case, it is advantageous to sample each sub-population independently. Regarding the stratification, Silver explains the following:

The present invention stratifies users into graded levels of health using a substantial range of wellness factors. The system then evaluates this stratification data and compares it to curves of similar factors for specific age groups. The curves which are closest to the calculated factors for the individual are a meaningful measurement of the equivalent physiological age of the individual.

(Silver, col. 5, ll. 38-45.) However, Silver fails to teach a comparing unit that compares the relative risk ratios and the correlated risk ratios *with empirical data* to generate comparative risk data to characterize the relative risks associated with the plurality of products, and a correcting unit that corrects the relative risk ratios in a case the comparative risk data is out of a defined range comparing with the empirical data, as required by Applicants' independent Claim 1. Silver is silent on such comparison with empirical data, and because Silver uses a stratification of the population to take into account sub-populations, so that no such correction by a comparison is needed.

Therefore, even if the combination of Flagg and Silver is assumed to be proper, the cited passages of the combination fails to teach every element of Applicants' Claim 1. Accordingly, Applicants respectfully traverse, and request reconsideration of this rejection based on these references.

Independent Claims 21 and 44 recite some features that are analogous to the features

recited in independent Claim 1 that were argued above, but directed to systems. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 21 and 44, and the rejections of all associated dependent claims, are also believed to be overcome in view of the arguments regarding independent Claim 1.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-10, 21-30, and 44-49 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

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